REMARKS

Claims 1-10, 20-25, and 27-30 were previously pending, of which claims 5 and 6 are canceled herein. New claims 31-35 have been added. Accordingly, claims 1-4, 7-10, 20-25, and 27-35 are pending. No new matter has been added.

Rejection under 35 U.S.C. § 103

Claims 1, 2, 7, 8, 10, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,389,028 to Bondarenko et al. ("Bondarenko") in view of U.S. Patent No. 4,788,715 to Lee ("Lee"), and further in view of U.S. Patent Pub. No. 2003/0061354 to Burg et al. ("Burg"). Claims 3, 5, and 6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bondarenko in view of Lee, in view of Burg, and further in view of U.S. Patent No. 6,049,603 to Schwartz et al. ("Schwartz"). Claims 4 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bondarenko in view of Lee, in view of Burg, and further in view of U.S. Patent No. 6,335,744 to Korilis et al. ("Korilis"). Claims 21-23, 25, 27, and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bondarenko in view of Burg, and further in view of Schwartz. Claims 24 and 29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bondarenko in view of Burg, in view of Schwartz, and further in view of Korilis. Claim 30 stands rejected under 35 U.S.C. §103 as being unpatentable over Bondarenko in view of Burg.

1. **Even when combined, the references do not teach the claimed subject matter.**

    As the PTO recognizes in MPEP §2142:

    The examiner bears the initial burden of factually supporting any prima facie *conclusion of obviousness. If the examiner does not produce a* prima facie *case, the applicant is under no obligation to submit evidence of nonobviousness.*

    The Examiner clearly cannot establish a *prima facie* case of obviousness in connection with the pending claims for the following reasons.

    35 U.S.C. §103(a) provides that:

    [a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the <u>subject matter as a whole</u> would have been obvious at the time the invention was made to a person

10

having ordinary skill in the art to which said subject matter pertains . . . .
(emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

Independent claim 1, as amended, recites *inter alia*:

> *responsive to the user terminating the call, the ACD further:*
> > *responsive to a subsequent call from the user, crediting the*
> *subsequent call with the tracked hold time; and*
> > *placing the subsequent call into the queue based on the hold time*
> *credited thereto, such that the subsequent call is placed into the queue ahead of*
> *calls that have shorter hold times associated therewith and behind calls that have*
> *longer hold times associated therewith.*

This feature is neither taught nor suggested by any of the cited combinations of references. The closest combination cited by the Examiner is Bondarenko in view of Lee, in view of Burg, and further in view of Schwartz, which combination the Examiner cited against claim 5, now canceled. In the rejection of claim 5, the Examiner conceded that the Bondarenko/Lee/Burg combination cited against claim 1 failed to disclose "tracking how much time the user has been on hold and crediting the user with time when a user calls back." The Examiner has taken the position that Schwartz remedies the deficiencies of Bondarenko/Lee/Burg in this regard at column 2, line 17, through column 3, line 27. Applicants respectfully traverse the Examiner's position for the following reasons.

In particular, the cited portion of Schwartz teaches, generally, providing to a caller a priority code corresponding to the caller's place in line (column 2, lines 48-49). When the caller calls back, the call is returned to the queue based on the priority code. Thus, the system of Schwartz clearly differs from that of Applicants. In particular, the queue placement priority, or preference, granted a subsequent call from a user in the system of Schwartz is based on the caller's place in line when a previous call is terminated. In contrast, in Applicants' system, as clearly recited in claim 1, the subsequent call is placed into the queue "based on the hold time credited thereto, such that the subsequent call is placed into the queue ahead of calls that have shorter hold times associated therewith and behind calls that have longer hold times associated therewith."

11

The functional difference between the two systems is clearly illustrated by the following example. Assume Caller A and Caller B call into the system taught by the combination of Bondarenko/Lee/Burg/Schwartz at 10:00 AM and 10:05 AM, respectively, on the same day. Caller A will be in line in front of Caller B. Assume further that Caller A decides to terminate the call immediately, rather than remain on hold, and Caller B remains on hold for 30 minutes before terminating the call. Both Caller A and Caller B are given priority codes to use when they call back later that day. If they both call back at the same time, Caller A will be placed in the line in front of Caller B. Applying the same example to Applicants' system, assuming again that Caller A and Caller B call back at the same time, Caller B will be placed in the line in front of Caller A, given the relative amounts of time the two callers remained on hold previously.

In view of the foregoing, it is apparent that claim 1 is allowable over the cited references and Applicants' respectfully request that the subject rejection thereof be withdrawn. Claims 2-4, 7-9, and 31 depend from and further limit claim 1 and are therefore allowable for at least the same reasons as claim 1.

Claims 10, 20, 21, and 30 include similar limitations to those of claim 1, described above, and are therefore also allowable for at least the same reasons as claim 1.

Claim 32 depends from and further limits claim 10 and is therefore allowable for at least the same reasons as claim 10. Claim 33 depends from and further limits claim 20 and is therefore allowable for at least the same reasons as claim 20. Claims 22-25, 27-29, and 34 depend from and further limit claim 21 and are therefore allowable for at least the same reasons as claim 21. Claim 35 depends from and further limits claim 30 and is therefore allowable for at least the same reasons as claim 30.

2.   The references are not properly combinable.

There is still another compelling, and mutually exclusive, reason why the cited combinations of references cannot be combined and applied to reject independent claims 1, 10, 20, 21, and 30 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was

*unknown and just before it was made. In view of all factual information, the
examiner must then make a determination whether the claimed invention "as a
whole" would have been obvious at that time to that person. ...[I]mpermissible
hindsight must be avoided and the legal conclusion must be reached on the basis
of the facts gleaned from the prior art.*

Here, references do not teach, or even suggest, the desirability of the various
combinations thereof. Indeed, none of the references provides any incentive or motivation
supporting the desirability of the combinations. Therefore, there is simply no basis in the art for
combining the references to support a 35 U.S.C. §103 rejection of claims 1, 10, 20, 21, and 30.

In this context, the MPEP further provides at §2143.01:

*The mere fact that references can be combined or modified does not render the
resultant combination obvious unless the prior art also suggests the desirability of
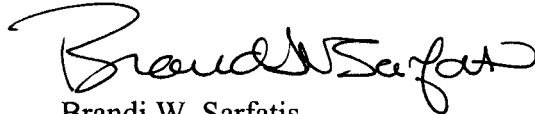the combination. (emphasis in original)*

In the above context, the courts have repeatedly held that obviousness cannot be
established by combining the teachings of the prior art to produce the claimed invention, absent
some teaching, suggestion or incentive supporting the combination. In the present case it is clear
that the Examiner's combination arises solely from hindsight based on the invention without any
showing, suggestion, incentive or motivation in any of the references for the combinations as
variously applied to claims 1, 10, 20, 21, and 30. Applicant's position in this regard is bolstered
by the fact that, with regard to the majority of the claims, the Examiner would have to pick and
choose from now fewer than four separate references in an attempt to recreate Applicant's
invention as recited in those claims. While the number of references combined by the Examiner
is not, alone, conclusive evidence of nonobviousness, it is certainly a factor to be considered.

Therefore, for this mutually exclusive reason, the Examiner's burden of factually
supporting a *prima facie* case of obviousness clearly cannot be met with respect to the pending
independent claims and the rejection under 35 U.S.C. §103(a) is not applicable and should be
withdrawn.

Conclusion

It is respectfully submitted that all of the claims currently pending in the application are in condition for allowance. Should the Examiner deem that any further amendment is needed to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the telephone number provided below.

Respectfully submitted,

Brandi W. Sarfatis
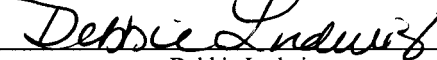Registration No. 37,713

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